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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,578	01/21/2000	Robert J. Snyder	1752.0010002	4622

7590 06/20/2002

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EXAMINER

HUYNH, BA

ART UNIT PAPER NUMBER

2173

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/488,578

Applicant(s)  
Holtz et al

Examiner  
First Last

Art Unit  
1234



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 5 6) ☐ Other: \_\_\_\_\_

BA/HUYNH  
PRIMARY EXAMINER

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## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because it is more than 150 words.

Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-17 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention as evidenced by the Alex Holtz's declaration in conjunction with the exhibits A, B, C submitted on 3/09/01. Disclosed in the declaration are numerous marketing activities by the applicants since 1996 which bring the claimed invention within the scope of a bar to patenting under 35 USC 102(b), including:

- 1996: Graphically disclosed the invention at the NAB 96 trade show.
- 4/1997: Demonstrated the first prototype, distributed brochures, market exploited, proposed price, list of potential beta sites was kept, among which is Rainbow Media Group. All at the NAB 97.

Sometime after the NAB 97: Discussed sale with price to public, including Rainbow Media Group.

- 6/1997: In Infocom trade show, repeated the same activities as in NAB 97.
- 10/1997: Disclosed the product (with significant portion of source codes), distributed brochures describing features and functions of the product at Telecon 97 trade show. Offered sale with price to public, including Rainbow Media Group. Capable and ready for taking purchase order.

- 12/19/1997: Sign a sale contract with Rainbow Media Group.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #RE37,342 (Washino et al), in view of US patent #5,115,310 (Takano et al).

- As for claims 1, 10, 16: Washino et al teach a computer implemented method and corresponding apparatus for producing a show in a video production environment (col. 2, lines 25-27) having a processing unit in communication with production devices (figure 1), comprising the steps/means for:

creating a script for the show, the script defines a set of video production commands (col. 6, lines 6-17),

executing the video command, the executing includes transmitting a control command from the processing unit to the video production device (col. 6, lines 27-46),

Washino et al fail to clearly teach the creating a story file for each of the segments within the show, each story file includes a subset of the video production commands, each of the subset corresponds to one of the show segments. However, in the same field of video production, Takano et al teach the creating a story file for each of the segments within the show, each story file includes a subset of the video production commands, and each of the subset corresponds to

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one of the show segments. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Takano's teaching of story file to Washino. Motivation of the combining is for having an hierarchy of show segments for ease of editing and transporting.

- As for claims 2, 8, 11: The story file is added to the show file before executing the first video production command (Takano's col. 3, lines 21-41).

- As for claims 3, 9, 12: subsequent story file are irreversibly appended to the show file prior to executing the first video production command (Takano's col. 2, lines 21-25, 49-53).

- As for claims 4: It is implicitly included that each subset of video production commands includes instructions for transitioning from the preceding segment to the subsequent segment.

- As for claims 5, 13: The show file is stored in a memory (col. 5, lines 24-25)

- As for claims 6, 14: Each segment is recorded for subsequent playback. Descriptive codes are added to the segments (col. 5, lines 22-25).

- As for claims 7, 15: The descriptive codes include time code stamps to identify the start of the video segment (col. 3, lines 21-25).

- As for claim 17:      - As for claims 1, 10, 16: Washino et al teach a computer implemented method and corresponding apparatus for producing a show in a video production environment (col. 2, lines 25-27) having a processing unit in communication with production devices (figure 1), comprising the steps/means for:

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creating a script for the show, the script defines a set of video production commands (col. 6, lines 6-17),

executing the video command, the executing includes transmitting a control command from the processing unit to the video production device (col. 6, lines 27-46),

Washino et al fail to clearly teach the creating a story file for each of the segments within the show, each story file includes a subset of the video production commands, each of the subset corresponds to one of the show segments. However, in the same field of video production, Takano et al teach the creating a story file for each of the segments within the show, each story file includes a subset of the video production commands, and each of the subset corresponds to one of the show segments. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Takano's teaching of story file to Washino. Motivation of the combining is for having an hierarchy of show segments for ease of editing and transporting.

Per Washino, the script can be narrative text instructions converted to script commands. Washino fail to clearly teach the converting of verbal instructions to script command. However, implementation of voice input is well known and the converting from voice input to script command would have been obvious in light of Washino teaching.

**Inquires**

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Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 746-7238 may be used for formal After Final communications, (703) 746-7239 for Official communications, or (703) 746-7240 for Non-Official or draft communications. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huynh-Ba whose telephone number is (703) 305-9794. The examiner can normally be reached on Monday-Friday from 8.00AM to 4.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Huynh-Ba  
Primary Examiner  
Art Unit 2173  
2/12/99

BA HUYNH  
PRIMARY EXAMINER